

Appl. No. : 10/692,089
Filed : October 23, 2003

COMMENTS

Claims 22-24 are now pending in the present application, Claims 9-21 having been canceled without prejudice or disclaimer and Claim 22 having been amended. The claims set forth above include marking to show the changes made by way of the present amendment, deletions being in ~~strikeout~~ and additions being underlined.

In response to the Office Action mailed March 3, 2005 Applicants respectfully request the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following comments.

Claims 11 and 12 Fully Satisfy the Requirements of 35 U.S.C. § 112, First Paragraph

Claims 11 and 12 stand rejected under 35 U.S.C. § 112, first paragraph, the Examiner's position being that the disclosure of the present application does not support the recitation of a "second shaft." Applicants respectfully point out that neither Claim 11 or 12 recite a "second shaft." Further, neither Claim 11 nor 12 recite any features that require a "second shaft." In any event, Applicants submit that the specification includes a disclosure of a camshaft that is driven by the crankshaft through a flexible transmitter. Thus, Applicants submit that the term "second shaft" is fully supported by the present specification.

In any event, in order to expedite prosecution of the present application, Applicants have cancelled Claims 11 and 12 without prejudice or disclaimer. Thus, the present rejection is moot. Applicants expressly reserve the right to further prosecute the original version of Claims 11 and 12 through continuation practice.

The Proposed Combination of Admitted Prior Art and Japanese Patent 2-125963 Does Not Make Obvious Claims 9-24

Claims 9-24 stand rejected under 35 U.S.C. § 103(a) as being obvious over the "admitted prior art," as shown in Figure 1 of the present application, in view of Japanese Patent 2-125963. Applicants respectfully traverse the present rejection. However, in order to expedite prosecution of the present application, Applicants have cancelled Claims 9-21 without prejudice or disclaimer. Additionally, Applicants have incorporated the subject matter of Claim 21 into Claim 22, thus placing Claim 22 into independent form. Applicants expressly reserve the right to further prosecute the original version of Claims 9-21 through continuation practice.

The admitted prior art of the present application, as illustrated in Figure 1, illustrates a flywheel 22 mounted to a crankshaft 20. As shown in Figure 1, the flywheel 22 includes a

Appl. No. : **10/692,089**
Filed : **October 23, 2003**

hub portion 26 which includes a first cylindrical portion having varying thicknesses and extending alongside of the crankshaft 20. The wheel portion 24 of the flywheel 22 is riveted to the hub portion 26. The wheel portion 24 is generally cup-shaped and defines a recess in which coils 28 are mounted.

However, the admitted prior art, as shown in Figure 1 of the present application, fails to disclose a flywheel assembly having a first portion that extends away from the end of the crankshaft and away from the engine body so as to form an inner wall of a recess, a second portion of the wheel extending generally perpendicular to the crankshaft so as to define the top wall of the recess, and the third portion of the wheel extending generally downwardly toward the engine body so as to define an outer wall of the recess, wherein coils are disposed within the recess.

It was the Examiner's position that Japanese Patent 2-125963 teaches coupling a portion of a flywheel to an end of a crankshaft to fasten the flywheel to the crankshaft. Additionally, the Examiner noted that any claimed thicknesses of the flywheel portions, a spacer between the crankshaft and the flywheel, a second shaft, and the specific shape of a flywheel would have been considered to be an obvious choice of mechanical design because one skilled in this art is familiar with the basic mechanics and normally has laboratory test facilities. Applicants respectfully disagree.

Firstly, however, Applicants would initially like to direct the Examiner to the annotated reproduction of Figure 8 provided below.

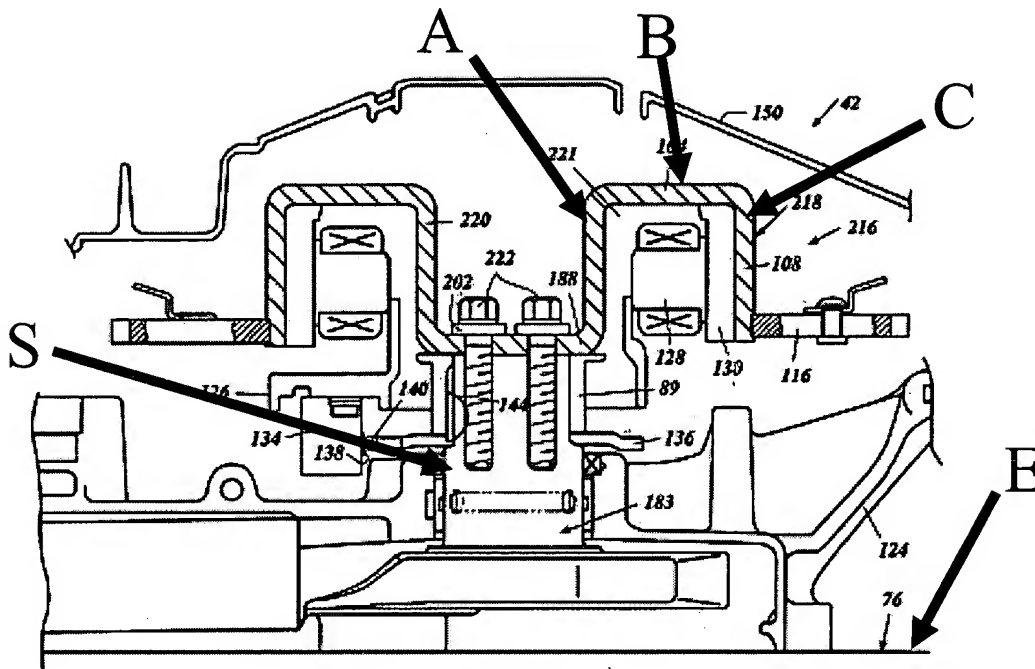


Figure 8

As shown in the non-limiting embodiment of Figure 8, the flywheel includes a first portion (identified by the letter A) that extends away from the end of the crankshaft 183 (identified by the letter S) and the engine body (identified by the letter E), a second portion (identified by the letter B) that extends generally perpendicular to the crankshaft 183 so as to define a top wall of the recess 221, and a third portion (identified by the letter C) that extends downwardly toward the engine body 76 so as to define an outer wall of the recess 221.

This feature provides an advantage, as disclosed in the present application. For example, as noted at Paragraph 0073, “the relatively short crankshaft 183 in this embodiment is advantageous because small size machining tools (e.g., cutting machines) can be used for producing the crankshaft 183. Also, the crankshaft 183 is lighter than the foregoing crankshafts 56, 155, 167, and thus can be more easily handled.” Further, as noted at Paragraph 0080, “the flywheel arrangement 216 [shown in Figure 8] is directly coupled with the top end of the short crankshaft 183.”

Nothing in the admitted prior art or Japanese Patent 2-125963 teaches or suggests the arrangement recited in Claim 22. Further, as noted above, the flywheel arrangement of the outboard motor recited in Claim 22 provides a distinct advantage. Thus, Applicants wish to point out that the improvements recited in Claim 22 are not mere obvious design choices.

Appl. No. : 10/692,089
Filed : October 23, 2003

In this regard, Applicants wish to point out that it has long been established that:

“The mere fact that a worker in the art **could rearrange the parts** of the referenced device to meet the terms of the claims [*sic.*] is not by itself sufficient to support a finding of obviousness. The prior art **must provide a motivation** or a reason for the worker in the art, without the benefit of [applicant’s] specification, to make the necessary changes in the referenced device.”

M.P.E.P. Section 2144.04 (emphasis added).

Applicants wish to note that neither the admitted prior art nor Japanese Patent 2-125963 provides any motivation for modifying the flywheel of the prior art to include the features recited in Claim 22.

For example, Claim 22 recites, among other recitations, “wherein a first portion of the wheel portion extends away from the end of the crankshaft and away from the engine body so as to form an inner wall of the recess, a second portion of the wheel portion extends generally perpendicular to the crankshaft so as to define a top wall of the recess, and a third portion of the wheel portion extends downwardly toward the engine body so as to define an outer wall of the recess.”

Further, as noted above, the flywheel arrangement for the outboard motor recited in Claim 22 provides clear advantages. Thus, Applicants submit that the features of Claim 22 are not mere obvious design choices, and thus, Claim 22 clearly and nonobviously defines over the references.

Additionally, Applicants submit that Claims 23 and 24 also define over the references, not only because they depend from Claim 22, but also on their own merit.

The Amendment Set Forth Herein Should be Entered

Applicants wish to note that the amendment to Claim 22 merely incorporates the subject matter of Claim 21, without any change. Thus, the amendment to Claim 22 does not raise any new issues. Applicants therefore respectfully request that the amendment to Claim 22 should be entered.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

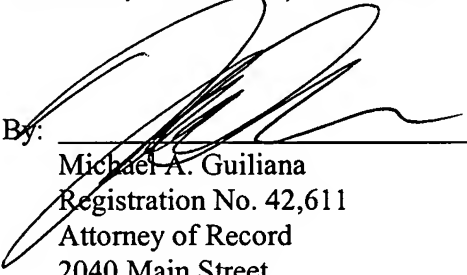
Appl. No. : 10/692,089
Filed : October 23, 2003

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicants' attorney in order to resolve such issue promptly.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: June 15, 2005

By: 
Michael A. Guiliana
Registration No. 42,611
Attorney of Record
2040 Main Street
Fourteenth Floor
Irvine, CA 92614
(949) 760-0404

1769749_1
061505